

Remarks

The Examiner divided the claims into the following restriction groups:

Groups I-IV. Claims 1-15 and 22-27, drawn to a promoter, and an expression cassette and plant comprising said promoter; wherein the invention encompasses a promoter having a specific sequence; and wherein the specific sequence for Groups I-IV is SEQ ID NO:1-4, respectively.

Group V. Claims 16 and 17, drawn to an available site of a plant which is obtained from a plant comprising at least one promoter promoting specific expression;

Group VI. Claims 18-20, drawn to a method for producing a desired gene product at a desired site; and

Group VII. Claim 21, drawn to a gene product.

As a preliminary matter, Groups I-IV of these restriction groups are based on SEQ ID NOs 1-4. SEQ ID NOs 1-3 represent exemplary promoters as claimed in dependent claims 25-27. In contrast, SEQ ID NO:4 represents a GenomeWalker primer (see page 48 of Specification). Thus, it is unclear why the Examiner has included SEQ ID NO:4 as the basis for a restriction group, as distinct from other primer sequences presented in the description.

Applicants traverse the restrictions, for reasons set forth below.

The present claims are in fact united by the common technical feature of comprising a promoter having been selected as promoting a desired specific expression based on an expression frequency of a gene including the promoter contained in a cDNA database. Applicants believe that there is no undue burden upon the Office to examine these claims, and respectfully request consideration of the amended claims without restriction.

The Examiner alleges that, given the teaching of Aharoni *et al.*, "it would not involve an inventive step to identify promoters associated with transcripts identified by this method" (page 3 of Office Action). However, this reference does not teach

the technical feature of the currently claimed subject matter, nor does it render the technical feature of the claims lacking inventiveness. The Aharoni *et al.* reference is a general teaching about the use of DNA microarrays to assess expression **patterns** of genes, and fails to teach any specific promoters at all, much less the currently claimed selection of a promoter operably linked to a gene, wherein the promoter has been selected as promoting a desired specific expression based on an expression **frequency** of the gene including the promoter contained in a cDNA database.

The observation of a variety of gene expression patterns taught by Aharoni *et al.* is not equivalent to and falls short of the instantly claimed plants, promoters, expression cassettes and methods for producing a desired gene product at a desired site of a plant. In order to achieve Applicants' claimed subject matter, the skilled artisan would need to make specific and nonobvious selections above and beyond the teaching of methods of identifying gene expression patterns taught by Aharoni *et al.* For example, a specific promoter promoting a desired specific expression based on a gene's expression frequency would need to be selected, the selected promoter operably linked to a gene, and, in some embodiments, the linked promoter and gene introduced into a plant. Thus, the common technical feature is not obvious in light of Aharoni *et al.*

Although Applicants traverse the restriction, to provide a reply that is considered complete, Applicants provisionally elect to begin prosecution with examination of Group I, claims 1-15 and 22-27. Applicants reserve the right to reintroduce the subject matter of the non-elected claims 16-21 of Groups II-VII into this or one or more timely filed continuation, divisional or continuation-in-part applications.

No fees are believed to be due in connection with this Amendment. However, the Director is authorized to charge any additional fees that may be required, or credit any overpayment, to Perkins Coie LLP Deposit Account No. 50-2207.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is encouraged to call the undersigned at (650) 838-4422.

Respectfully submitted,

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Date: August 2, 2007

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